

without further punishing Chase by awarding [attorneys'] fees and costs." We conclude, however, that the district court did not abuse its discretion in the circumstances of this case.

A court may award costs and "may also award a reasonable attorney's fee to a prevailing party, as part of the costs." U.S.C. § 305. Chase is correct in noting that such awards are not to be made as a matter of course, but, rather, as a matter of the court's discretion. See *Fogerty v. Fantasy, Inc.*, 114 F.3d 1023, 1033 (9th USFQ2d 1881) (1994). In exercising such discretion, we have instructed district courts to consider: (1) the motivation of the parties; (2) the objective, reasonableness, of the legal and factual positions advanced; (3) the need in particular circumstances to advance considerations of compensation and deterrence; and (4) any other relevant factors presented. See *Macmillan, Inc. v. Astec, Inc.*, 1 F.3d 225, 234 (7th USFQ2d 1678) (4th Cir. 1993).

[4] Chase maintains that he had a reasonable basis to test the legal question of whether animal mannequins are copyrightable and thus he should not be assessed legal fees for doing so. He points to the district court's assessment that the case "presented legal questions that were novel and complex." We agree that if Chase had pursued these legal issues in good faith, an award of attorneys' fees would constitute an abuse of discretion. But the record in this case belies this suggestion that Chase maintained his legal position in good faith.

The record shows that Chase adopted a business practice of copying animal mannequins created by competitors, justifying the practice with the claim that animal mannequins are not copyrightable. As a result of this practice he has been sued repeatedly for copyright infringement. At the same time that he was making the contention that animal mannequins are not copyrightable, however, he was applying for copyrights for his own mannequins, affixing copyright notices to them, and warning others that his mannequins are "legally copyrighted" and "may infringement will be vigorously prosecuted." When one of his fish mannequins was found by a court to be not copyrightable — a decision that he now argues vindicates his contention that animal mannequins are not copyrightable — he nevertheless continued to warn the public, "Beware of look-alikes," and "[D]esperately copy cat" [are] "working overtime in an attempt to deceive the public and violate the rights of others." (Emphasis added). Moreover, he continued to attach copyright notices to his mannequins to

focus. . . . finding is simply supported. Under such circumstances, we do not find the district court's award in this case to constitute an abuse of discretion.

For the foregoing reasons, the judgment of the district court is

AFFIRMED.

U.S. Court of Appeals
Federal Circuit

In re Alton
No. 94-1495
Decided February 5, 1996

PATENTS

1. Practice and procedure in Patent and Trademark Office — Procedural — Declaration/Affidavits (§110, 912)

Patentability/Validity — Specification — Written description (§115, 1103)

Patent examiner erred by viewing declaration of person skilled in art as opinion evidence addressing question of law rather than question of fact, since declaration attempted to shed light on question of whether specification adequately described subject matter of application claim, since that question is one of fact, and since declaration, rather than asserting opinion on patentability of claimed human gamma interferon analog, offers factual evidence in attempt to explain why one of ordinary skill would have understood specification to describe particular analog claimed.

2. Practice and procedure in Patent and Trademark Office — Prosecution — Declaration/Affidavit (§110.0913)
Patentability/Validity — Specification — Written description (§115.1103)

Patent examiner erred by dismissing declaration of person skilled in art without adequate explanation of how declaration failed to overcome prima facie case for rejection on ground that application did not provide adequate written description of subject matter in claim for human gamma interferon analog. Since statement in examiner's answer that specification "encompasses" substantial number of possible analogs does not refute thrust of declaration, which explains why one of ordinary skill in art would have realized that applicants had possession of one particular analog on their claimed filing date.

the decision and remand the case to the Board for further proceedings.

BACKGROUND

IFN- γ is a protein secreted by cells in the human immune system to stimulate immunological activity. Patrick W. Gray et al., *Expression of Human Immune Interferon cDNA in E. Coli and Monkey Cells*, 295 *Nature* 503 (1982). IFN- γ is believed useful because it activates macrophages, which are a class of cells in the immune system. Bruce Alberts et al., *Molecular Biology of the Cell* 1049 (2d ed. 1989). IFN- γ is composed of a sequence of 146 amino acids. The complete sequence is divided into four subunits. IFN- γ polypeptides containing alterations in the naturally occurring amino acid sequence are called "analogues".

Claim 70 of the '451 application, set forth below, recites an analog of IFN- γ :

[Met]-[des-Cys]-[des-Tyr]-[des-Cys]-IFN- γ polypeptide produced by a DNA sequence coding therefor in a transgenic organism, said product having substantially the characteristics of human IFN- γ (brackets in original).

The bracketed words at the beginning of the claim indicate how the claimed IFN- γ differs from the natural version of IFN- γ . "Met," "cys," and "tyr" are abbreviations for three of the twenty amino acids; they stand for methionine, cysteine, and tyrosine, respectively. A positive superscripted number following the abbreviation of an amino acid indicates the position of that amino acid in the 146 amino acid chain that comprises IFN- γ . For example, "tyr", means that tyrosine is the second amino acid in the 146 amino acid chain. The designation "des" preceding the name of the amino acid indicates that that particular amino acid has been deleted and no amino acid has been substituted in its place. Therefore, "[des-cys]-[des-tyr]-[des-cys]-IFN- γ ", means that the cysteine at position one of the amino acid chain has been removed, as has the tyrosine at position two.

We understand the parties to be in agreement on the facts regarding the technology in this case.

Amino acids, of which there are twenty, are small organic molecules. Benjamin Lewin, *Genes V* 11 (1994). Amino acids combine in linear chains to form proteins. *Id.* at 14. A protein is sometimes referred to as a polypeptide.

The 146-amino acid sequence of the IFN- γ analog recited in claim 70 is attached to this opinion.

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Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of Norman K. Alton, Mary A. Peters, Yitzhak Tabinski, and David L. Solzman, serial no. 06/483,451, filed April 15, 1983, which is continuation-in-part of application filed May 6, 1983, now abandoned. From decision upholding examiner's rejection of application claim 70 for failure to comply with written description requirement of 35 USC 112, applicants appeal. Vacated and remanded.

Michael F. Bocin, of Marshall, O'Toole, Gershten, Murphy, & Bourin, Chicago, Ill.; Li-Hsien Lin-Lau, Chicago, Ill.; Steven M. Odic, Thousand Oaks, Calif.; Robert R. Cook and Ron K. Levy, Thousand Oaks, for appellants.

Scott A. Chambers, associate solicitor; Nancy J. Link, solicitor; Albin F. Drost, deputy solicitor, and Richard Terezos, associate solicitor, Arlington, Va., for appellee. Before Michel, circuit judge, Friedman, senior circuit judge, and Schall, circuit judge.

Schall, J.

Appellants Norman K. Alton, et al. ("Alton"), appeal the ruling of the United States Patent and Trademark Office/Board of Patent Appeals and Interferences ("Board") in Appeal No. 10-3098. In its decision, the Board held that the specification of application serial number 06/483,451, ("the '451 application") did not provide adequate written descriptive support for the amino acid sequence of human gamma interferon ("IFN- γ ") described in claim 70. We vacate

tyrosine at position two and the cysteine at position three. A negative superscripted number indicates that an amino acid has been added onto the beginning (the N-terminus) of the IFN- γ sequence. Thus, "met-," means that a methionine has been placed at the beginning of the IFN- γ amino acid chain.

In sum, the analog of IFN- γ recited in claim 70 has two characteristics that distinguish it from the natural version of IFN-IFN- γ . First, as "[des-cys, -met-, des-cys]," indicates, the first three amino acids — cysteine, tyrosine, and cysteine — of the natural 146 amino acid sequence have been deleted from the claimed IFN- γ analog. These three amino acids are located on the fourth subunit ("IFN- γ 4") of the complete sequence. Second, methionine has been placed at the beginning of the amino acid sequence of the claimed analog.

The '451 application's specification contains twelve examples of IFN- γ analogs. Of these, Example 5 is closest to the analog that is the subject of claim 70. Like claim 70, it discloses deletion of the first three amino acids and placement of methionine at the beginning of the amino acid sequence of IFN- γ "[met-, -des-cys, -des-cys, -des-cys]". Unlike claim 70, however, Example 5 additionally discloses substitution of asparagine — the eighty-first amino acid in the IFN-IFN- γ chain — with lysine, another amino acid ("lys"). The eighty-first amino acid is located on the second subunit ("IFN- γ 2") of the IFN- γ sequence.

II.

The '451 application was filed April 15, 1983. It is a continuation-in-part of a parent application filed on May 5, 1982, and later abandoned. The examiner issued a final rejection of the claims of the '451 application as anticipated under 35 U.S.C. § 102(e) and rendered obvious over the prior art under 35 U.S.C. § 103.

Alton appealed the examiner's final rejection to the Board. On February 28, 1991, the Board reversed the examiner's section 102 and 103 rejections but rejected the claims on new ground that the specification failed to describe adequately the subject matter of the claims, as required by 35 U.S.C. § 112, I. The Board stated: "The closest analog to that claimed herein is described [in Example 5]. This particular analog, though similar to that claimed herein, does not constitute a description of the claimed analog."

Electing further prosecution pursuant to 37 C.F.R. § 1.196(b), Alton submitted to the

examiner, in response to the Board's section 112, I rejection, a declaration by Dr. Randolph Wall (the "Wall declaration"). In due course, the examiner issued a final rejection on the same grounds as had the Board. Alton then requested reconsideration; the examiner denied the request and maintained his rejection ("final rejection").

Alton appealed the final rejection of claim 70 to the Board. The examiner filed his Answer and the Board sustained the section 112, I rejection on June 21, 1994. In its decision, the Board held that "the specific polypeptide of claim 70 was not described in the original specification of application Serial No. 06/483,451." The Board adopted the examiner's dismissal of the Wall declaration, which the examiner reasoned that the declaration was opinion evidence rather than factual evidence. The examiner stated, "Little weight is given an opinion affidavit on the ultimate legal question at issue." This appeal followed.

DISCUSSION

I.

The issue of whether a patent specification adequately describes the subject matter claimed is a question of fact. *Vas-Cath, Inc. v. Mahurin*, 933 F.2d 1555, 1563, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991). We review questions of fact arising from Board rejections under a clearly erroneous standard. *In re Coveney*, 761 F.2d 671, 674, 225 USPQ 1, 3 (Fed. Cir. 1983). We review questions of law *de novo*. *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 715, 21 USPQ2d 1388, 1390 (Fed. Cir. 1992).

II.

Alton contends that the Board committed clear error in holding that the '451 specification did not describe the subject matter of

When the Board of Patent Appeals and Interferences makes a new rejection of an appealed claim, the applicant may ... submit ... a showing of facts ... and have the matter reconsidered by the examiner in which event the application will be remanded to the examiner. The statement shall be binding upon the examiner unless an amendment or showing of facts, not previously of record be made which, in the opinion of the examiner, overcomes the new ground for rejection stated in the decision. Should the examiner again reject the application, the applicant may again appeal to the Board of Patent Appeals and Interferences.

37 C.F.R. § 1.196(b) (1994) states:

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chain 70. Alton additionally argues that the Board erred in failing to give substantial weight to the Wall declaration.

The adequate written description requirement of 35 U.S.C. § 112, ¶ 1, provides that: [t]he specification shall contain, a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
(emphasis added.)

The adequate written description requirement, which is distinct from the enablement and best mode requirements, serves "to ensure that the inventor had possession, as of the filing date, of the application relied on, of the specific subject matter later claimed by him, how the specification accomplishes this if not material." *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 2d 96 (CCPA 1976). In order to meet the adequate written description requirement, the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosselé*, 872 F.2d 1008, 1012, 10 JPL USPQ2d 1614, 1618 (Fed. Cir. 1989). (Citation omitted). Put another way, "the applicant must ... convey, with reasonable clarity, to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Var-Cath*, 935 F.2d at 1562, 19 USPQ2d at 1127. Finally, we have stated that "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." *Eisenstein v. Novak*, 57 F.3d 1035, 1039 (Quinton USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting *Var-Cath*, 935 F.2d at 1561, 19 USPQ2d at 1116)).

³In order to be considered enabling, a patent must give persons of ordinary skill in the relevant art enough information to practice the invention disclosed in the specification without undue experimentation. *Miles Powder Co. v. El. Co.*, 224 F.2d 60, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984). The best mode requirement mandates that the inventor disclose enough information to enable others to practice the invention. *Id.* See also *General Specialty Co. v. Columbia*, 327 F.2d 1524, 1535, 3/3 USPQ2d 1732, 1745 (Fed. Cir., cert. denied, 444 U.S. 924, 949713).⁴

As noted above, following the Board's decision of February 26, 1991, Alton elected further prosecution pursuant to 37 C.F.R. § 1.196(b). In that context, Alton submitted the Wall declaration in response to the Board's section 112, 11 rejection. In paragraph 99 of his declaration, Dr. Wall addressed the issue of whether Example 5 in the specification described what was claimed in claim 20.

3. The specific modifications of substituent IF-4 for deleting both cysteines and the intermediate tyrosine at amino acid positions 1, 2, and 3 are set out at page 50, lines 11 and 12, which describe modification of the IF-4 substituent (which contains a methionyl residue specifying codon at position 1) to contain the codons.

5'-ADG-CAG-3'

3'-TAC GTC-5'

in the amino acid specifying region: ATG is a codon specifying methionine; CAG is a codon specifying glutamine. Expression of κ complete, four subunit, DNA sequence with this modification in subunit I-E⁴ operatively provides a polypeptide of chains 70, It is my opinion that skilled workers in molecular biology and the cloning and expression of κ -genes would, in 1983, have understood the proposed modification ("des-cys", "des- κ -cys") to have been described independently of any suggestion to alter the arginine [κ (asparagine)] residue at position 81 of mature human immune interferon. While the specific analog including both the changes in the mature human immune interferon was described as being made and tested, that compound was noted to be an "example" of polypeptide analogs wherein cysteines were deleted for the purpose of facilitating insertion of analogs by destroying the possibility of intermolecular disulfide bridge formation. Modifying the residue at position 81 would have no effect on this property, because neither arginine [κ (asparagine)] nor lysine can

"The parties do not dispute that Dr. Wall has the requisite skill in the art.

'We understand the parties to be in agreement that recitation in the Wall declaration of the "amino acid "arginine," instead of "asparagine," was a typographical error.'

Cysteines contain a sulfhydryl group. Two cysteines can form a disulfide bridge, causing the amino acid chain to bond back on itself. ¹⁴

In re Alton

37 USPQ2d

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participate in disulfide bridge formation. Moreover, changing to [sic] residue at position 81 would involve a modification in subunit IFN-2, requiring an entirely separate series of manipulations of the complete DNA sequence to generate this different class of analog.

Among other things, the Wall declaration states that one of ordinary skill in the art in 1983 would have known, first, that a problem involved with isolating analogs was the capacity of the amino acid sequence to form bonds with itself through disulfide bridges, and second, that deletion of cysteines would eliminate this phenomenon. According to Dr. Wall, one of ordinary skill in the art would have understood the discussion in the specification of Example 5 to be offered as an illustration of the deletion of cysteines. Therefore, according to Dr. Wall, one of ordinary skill in the art, knowing that deleting the first three amino acids of the complete sequence would affect disulfide bridge formation but that the existence of lysine at position 81 would not, would have understood the specification to describe the two modifications independently. Also according to Dr. Wall, a second reason one of ordinary skill in the art would have understood the specification to describe the two modifications independently is that the first three amino acids are located on subunit IFN-4, whereas the eighty-first amino acid is located on subunit IFN-2.

In his final rejection, which was adopted by the Board, the examiner stated that the specification did not convey that Alton had possession of the subject matter of claim 70 as of April 15, 1983 — the filing date of the '451 application. In support of the rejection, referring to Example 5, the examiner asserted that the only example in the specification that described deletion of the first three amino acids and placement of methionine at the beginning of the amino acid sequences of IFN- γ additionally described substitution of asparagine — the eighty-first amino acid in the IFN- γ chain — with lysine, another amino acid. Turning to the Wall declaration, the examiner stated:

In order to support patentability of the claims Dr. Wall points to the same text of the specification as previously identified by the Board of Patent Appeals and Interferences as being insufficient. Importantly, Dr. Wall arrived at a conclusion which is opposite that determined by the Board. In view of the previous discussion of the Board of Patent Appeals and Interfer-

ences and the evidence of record, this argument is not found to be persuasive. . . . The weight given to the 132 Declaration by Dr. Wall, in particular paragraph . . . 93, depends on whether it presents allegations, opinions or facts. In this case the Declaration does not point to inherent support or evidence to support the conclusory statement in paragraph 93. Little weight is given an opinion affidavit on the ultimate legal question at issue.

In short, the examiner rejected Dr. Wall's opinion that "a skilled worker in molecular biology and the cloning and expression of genes, would, in 1983, have understood the proposed modification to have been described independently of any suggestion to alter the arginine [sic] residue at position 81 of mature human immune interferon." The examiner maintained this position in his Answer. In his Answer, the examiner stated that:

the Wall Declaration does not suggest that the written description in the specification supports an interferon-gamma which *must* have the claimed structure. Indeed, the number of possible interferon-gamma analogs encompassed by the written description of the invention is substantial and the specification does not lead to any compound which *must* have the claimed structure.

As already seen, the Board adopted as its own the examiner's response to Alton's arguments.

We express no opinion on the factual question of whether the specification adequately describes the subject matter of claim 70. We do, however, hold that the examiner's final rejection and Answer contain two errors: (1) viewing the Wall declaration as opinion evidence addressing a question of law rather than a question of fact; and (2) the summary dismissal of the declaration without an adequate explanation of why the declaration failed to rebut the Board's prima facie case of inadequate description.

III.

A. The Examiner Erred by Mistaking a Question of Fact for a Question of Law

¹ See *Fiers v. Rosel*, 984 F.2d 1364, 1171, 25 USPQ2d 1501, 1606 (Fed. Cir. 1993) ("[U]nlike a conception of: DNA requires a precise definition, such as by structure, formula, 'chemical name, or physical properties . . . then a description also requires that degree of specificity.")

As was above, in the final rejection, the examiner stated that the weight given to Dr. Wall's declaration

depended on whether it presents allegations, opinions or facts. In this case the declaration does not point to inherent support of evidence to support the conclusory statement in paragraph 39. Little weight is given an opinion affidavit by the ultimate legal question at issue.

In his Answer, the examiner continued that:

It is apparent the "Opinion" emphasis added by Dr. Wall that, as of the filing date of this application, one skilled in the art would have interpreted "...the specification would guarantee the x class of tripeptide analogs having the cysteine residue at the amide terminus." Little weight is given an opinion affidavit as the ultimate legal question at issue regarding written description for the invention now claimed.

[4] It is well settled that the question of whether a specification provides an adequate written description of the subject matter of the claims is an issue of fact. Therefore, the examiner was in error when he stated that the Wall declaration, which attempted to shed light on whether the '451 specification adequately described the subject matter of claim 10, addressed a legal issue.

Additionally, the examiner interpreted the "Wall" declaration as offering opinion evidence, rather than factual evidence, on the subject matter claimed in the '451 specification. The examiner's interpretation that "involving the residue at position 81" would have no effect on "[d]isulfide bridge formation" because "either [emphasis] for valine can participate in disulfide bridge formation" is a factual statement, however. So too is the statement that changing the amino acid at position 81 would involve a modification in substituent 182, "requiring no entirely separate series of manipulations of the original [amino acid] sequence to generate this different class of analog." We do not read the declaration as offering an opinion on the patentability of the claimed 17/17-7 analog. Rather, the declaration is offering factual evidence in an attempt to explain why one of ordinary skill in the art would have understood the specification to describe the modification involving the deletion of the first three amino acids independently of the modification at position 81. Dr. Wall's use of the words "it is my opinion" to preface what someone of ordinary skill in the art would have known does not transform the factual statements contained in the declara-

tion into opinion/testimony.¹⁶ Consequently, the examiner's dismissal of the declaration on the grounds that "[l]ittle weight is given an opinion affidavit on the ultimate legal question at issue" was error.

B. The Examiner Erred by Failing to Urge Adequate Support for the Rejection

The examiner also erred by dismissing the Wall declaration without an adequate explanation of how the declaration failed to overcome the prima facie case initially established by the Board in the rejection on the ground that the application failed to describe the subject matter of claim 10. The examiner (or the Board, if the Board is the first body to raise a particular ground for rejection) "bears the initial burden . . . of presenting a prima facie case of unpatentability." *Ex parte Oetiker*, 537 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Insofar as the written description requirement is concerned, this burden is discharged by "presenting evidence or reasons why persons skilled in the art would not necessarily in the disclosure a description of the invention defined by the claims." *Worthington*, 543 F.2d at 763, 191 USPQ at 92. Thus, the burden placed on the examiner varies depending on what the applicant claims. If the applicant claims embodiments of the invention that are completely outside the scope of the specification, then the examiner or Board need only establish this fact to make out a prima facie case. *Id.* at 263-64, 191 USPQ at 97. If, on the other hand, the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide evidence why one of ordinary skill in the art would not consider the description sufficient. *Id.* at 264, 191 USPQ at 98. Once the examiner or Board carries the burden of making out a prima facie case of unpatentability, "the burden of coming forward with evidence or arguments shifts to the applicant." *Oetiker*, 537 F.2d at 1443, 24 USPQ2d at 1444. To overcome a prima facie case, an applicant must show that the invention as claimed is adequately described.¹⁷

¹⁶ In any event, we are aware of no reason why opinion evidence relating to a fact, here should not be considered by an examiner. See *Athlon Oil, Inc. v. Delta Resins & Refractories, Inc.*, 756 F.2d 281, 294, 222 USPQ 657, 663 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986).

and skilled in the art: "After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of the evidence with due consideration to persuasiveness of argument." *Id.* at 1445, 24 USPQ2d at 1444.

After claim 70 was first rejected on section 112, 1 1/2 grounds, Alton submitted evidence to rebut the rejection in the form of the Wall declaration.¹¹ The Wall declaration contained statements of fact directly addressing the issue of whether the specification adequately described the subject matter recited in claim 70. The purpose of the adequate written description requirement is to ensure that the inventor had possession of the claimed subject matter at the time the application was filed. If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claim is not explicitly described in the specification, then the adequate written description requirement is met. For example, in *Watson Purina Co., Inc. v. Far-Mar Co., Inc.*, 732 F.2d 1570, 1576/227 USPQ 1, 180 (Fed. Cir. 1985), the trial court "admitted" expert testimony about known industry standards "regarding temperature and pressure in 'the art of extrusion of both farmaceous and proteinaceous vegetable materials.' The effect of this testimony was to expand the breadth of 'the' actual written description since it was apparent that the inventor possessed such knowledge of industry standards of temperature and pressure at the time the original application was filed. Similarly, the Wall declaration in essence attempts to expand the breadth of the specification by arguing that a person of ordinary skill in the art would have understood the two modifications in Example 5 of the specification to be described independently of each other and thus a description of both modifications would include a description of either separately.

The thrust of the examiner's response to the Wall declaration, in both the final rejection and the Answer, is that the specification must describe the precise analog claimed. This explains why the examiner stated that the Wall declaration was inadequate because it did not "suggest" that the written description in the specification supports an

interferon-gamma analog which *must* have the claimed structure.¹² This argument, however, does not address the point that paragraph 91 of the Wall declaration attempts to make: that one of ordinary skill in the art would have understood the specification to describe the two modifications ("met", "des-cys", "des-tyr", "des-cys") independently and that the description of both modifications together would be relevant as an example of only one of those modifications ("met", "des-cys", "des-tyr", "des-cys"). Thus, according to the Wall declaration, the specification would be understood to describe the relevant modification ("met", "des-cys", "des-tyr", "des-cys") without the irrelevant one ("tyr"). Therefore, according to the Wall declaration, one of ordinary skill in the art would understand Alton to be in possession, in 1983, of the claimed subject matter, which contained the ["met", "des-cys", "des-tyr", "des-cys"] modification but not the modification at position 81.

[2] The Wall declaration addresses why the claimed subject matter, although not identical to the analog described in the specification, was in Alton's possession. The statement in the examiner's answer that the number of possible analogs encompassed by the specification is substantial does not rebut the thrust of the Wall declaration because the Wall declaration explains why one of ordinary skill in the art would have realized that Alton had possession of one particular analog. In sum, in its final rejection and again in its Answer, the examiner dismissed the Wall declaration and provided only conclusory statements as to why the declaration did not show that a person skilled in the art would realize that Alton had possession of the claimed subject matter in 1983.

CONCLUSION

First, by concluding that the Wall declaration addressed an issue of law instead of an issue of fact, and second, by failing to articulate adequate reasons to rebut the Wall declaration, the examiner and Board failed to consider the totality of the record for the purpose of issuing a final rejection and thus erred as a matter of law. We are not in a position, however, to determine whether the specification contained an adequate written description of the claimed IFN- γ sequence. That determination requires, in the first instance, further proceedings in which the Wall declaration is addressed in a manner that is consistent with this opinion. This case is remanded to the Board for such further proceedings. See *In*

¹¹ We are satisfied that the Board met its prima facie case of establishing lack of adequate written description in its 1994 decision by discussing Example 5 of the specification, in which both modifications appeared together.

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Rolex Watch U.S.A. Inc., New York

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re Beaver, 893 F.2d 328, 13 USPQ2d 1409 (Fed. Cir. 1989) (vacating Board's decision for failing to review all the appealed claims in accordance with the relevant regulations).

Each side to pay its own costs. **VACATED and REMANDED.**

RENTAL AGREEMENT

CYS-TYR-CYS-Glu-Asp-Phe-Tyr-Val-Lys-Gln-Ala-Glu-Ala-Leu-
 TUT-TAC-AGC-CAG-CAA-TAT-GTA-AAA-GAA-GCA-GAA-His-CTT
 10
 Lys-Ala-Tyr-Phe-Ala-Ala-Ala-
 AAG-ATA-PAT-TTC-AAA-GCA-GCT-GAT-TGA-GAT-GAA-GGG-GAT-AAA
 20
 Gly-Tyr-Lys-Lys-Phe-Lys-Glu-
 GGA-ACT-CTT-TTC-TGA-GGC-ATT
 30
 Ser-Ala-Ala-Lys-Ile-Met-Gln-
 AGT-GAC-AGA-AAA-ATA-ATG-CAG-AGC-CAA-ATG-TTC-CCG-TAC
 40
 Phe-Lys-Phe-Lys-Ala-Phe
 TTC-AAA-CTT-TTT-AAA-AAA-
 50
 Lys-Ser-Val-Gln-Glu-Ile-Lys
 AAG-AGT-GTG-GAG-AGG-ATC-AAG-GAA-GAC-ATG-AAT-GTC-AAG-TTT
 60
 Phe-Ala-Ser-Ala-Lys-Lys-Lys
 ITC-AAT-AGC-AAC-AAA-AAG-AAA
 70
 Thr-Ala-Tyr-Ser-Val-Ala-
 ACT-AAT-TAT-TTC-GTA-ACT-GAC-
 80
 Ile-His-Glu-Isole-
 ATA-CAT-GAA-CTG-CTG-ATC-GAA
 90
 Ala-Lys-Tyr-Gly-Lys-Ala-Lys
 GCT-AAA-ACG-GGG-AAG-CGA-AAA-AGG-GAT-CAG-ATG-CTG-TTC-CAA
 100
 Met-Ala-Gln-Leu-Ser-Pro-Ala-
 ATG-GCT-GAA-CAT-TGG-CTG-CAA-GCA
 110
 120
 130
 140

**U.S. Court of Appeals
Sixth Circuit**

Rolex Watch U.S.A. Inc. • Crowley

Nov. 94-6459/6460

Divided February 2, 1996

JUDICIAL PRACTICE AND

PROCEDURE

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Non-monetary and Injunctive—Equitable relief—Remedies—Injunctions

Trademarks and unfair trade practices (8505.0709.09)

Federal district court did not err by finding incredible defendant's assertion that she exercised dominion or control over jewelry store found to have violated terms of permanent injunction restricting defendant's use of "Ruler" trademark and that she can be personally held in contempt, since defendant agreed to comply with injunction after date on which he sold certain jewelry store purports defendant state injunction is intended to follow defendant wherever he goes, since defendant is "obligated" to abide by terms of settlement agreement with regard to jewelry store at all times, and since injunction is legal obligation defendant assumed equally with her co-defendant husband. *ATP*

* * * TRANSMISSION RESULT REPORT (OCT.29.2003 4:46PM) * * *

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DATE	TIME	ADDRESS	MODE	TIME	PAGE	RESULT	PERS. NAME	FILE
OCT.29.	4:35PM		USPTO TES	10'50"	P.19	OK		919

M : BATCH
S : MEMORY
U : STANDARD

C : CONFIDENTIAL
D : SEND LATER
B : DETAIL

S : TRANSFER
F : FORWARDING
E : FINE

P : POLLING
E : EOM
R : REDUCTION